

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte MARK J. KRAFFERT

Appeal No. 2006-1778  
Application No. 09/776,364

ON BRIEF

MAILED

JUL 27 2006

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Before THOMAS, KRASS, and RUGGIERO, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellant has appealed to the Board from the examiner's final rejection of claims 1 through 14, 17 through 21 and 23 through 32.

Representative independent claim 1 is reproduced below:

1. A method of performing a test, comprising:

performing a first test with a first test system;

performing a second test with a second test system;

in each of the first and second test systems, receiving plural parameters;

in each of the first and second test systems, identifying a file name of a first data file to use in each of the first and second tests based on the plural parameters; and

the first and second test systems using the first data file in performing the respective first and second tests.

The following references are relied on by the examiner:

Fujimori	5,517,892	May 21, 1996
Walls et al. (Walls)	5,848,410	Dec. 8, 1998
Fitting	5,857,192	Jan. 5, 1999
Gartner et al. (Gartner)	6,393,435	May 21, 2002 (Filed Sept. 22, 1999)
Talley	6,513,047	Jan. 28, 2003 (Filed Sept. 4, 1997)
Slutz	6,581,052	Jun. 17, 2003 (Filed Oct. 2, 2000)

Claims 1 through 14, 17 through 21 and 23 through 32 stand rejected under 35 U.S.C. § 103. In a first stated rejection, the examiner relies upon Slutz in view of Fujimori as to claims 1, 2 and 5 through 13. In the examiner's second and third stated rejections, the examiner respectively adds Talley to the initial combination of references as to claims 3, 4, 14, 17 through 19, 23, 24 and 27 through 32, with a further addition of Walls as to claims 20, 21, 25 and 26. In a fourth stated rejection the examiner relies upon Gartner and Fitting as to claims 1 through 14, 17 through 19, 23, 24 and 27 through 32, with the addition of Walls as to claims 20, 21, 25 and 26 in a fifth stated rejection.

Rather than repeat the positions of the appellant and the examiner, reference is made to the amended brief filed on December 21, 2004, the reply brief and the supplemental reply brief for appellant's positions, and to the answer and supplemental answer for the examiner's positions.

OPINION

Although we sustain the rejection of claims 1 through 14, 17 through 21 and 23 through 32, all claims on appeal, within 35 U.S.C. § 103, we do not sustain each of the examiner's respectively stated rejections of these claims. Among the first through third stated rejections relying initially upon the combination of Slutz and Fujimori, we sustain the rejection of independent claim 1 and dependent claim 2. Thus, among the stated rejection of claims 5 through 13 and all remaining claims on appeal rejected in the second and third stated rejections respectively relying upon Talley and Walls, we reverse these rejections. On the other hand, we sustain the fourth and fifth stated rejections respectively relying upon Gartner in view of Fitting, further in view of Walls. The arguments in the respective briefs and answers have proceeded generally along the lines set forth by appellants grouping at page 7 of the amended appeal brief.

To present a general overview of the subject matter of the respective independent claims on appeal, only independent claims 1 and 28 relate to plural test systems. Independent claim 1 only broadly recites the identification of a file name as being "based on" plural parameters. Each of the remaining independent claims 6, 14,

23, 27 and 28 recites either the combination or the concatenation of the respective parameters. Otherwise, each independent claim reflect common subject matter in different degrees of specificity.

As indicated earlier, as to the first stated rejection of claims 1, 2 and 5 through 13 relying upon Slutz in view of Fujimori, we sustain only the rejection of independent claim 1 and its dependent claim 2. No arguments are presented in the various briefs as to dependent claim 2.

As to independent claim 1 on appeal, we note first that there is no recitation in claim 1 that the first test is different than or the same as the second test and that the first test system is the same or different than the second test system. Moreover, the recitation of “a first data file” does not require that the same data is used by both test systems to perform a “same” first and second test. Again, note that claim 1 does not require that the parameters be combined or concatenated, only that the tests are broadly defined to be “based” on the parameters.

With this background in mind we agree with the examiner’s analysis of Slutz only as it applies to independent claim 1 on appeal based upon the examiner’s position set forth at least at pages 4, 14 and 15 of the answer as well as the remarks at pages 6 and 7 of the supplemental answer. A major focus of appellant’s arguments in the

various briefs is that the “same” data file is required because of the recitation of “the first data file” as argued. From our consideration of Slutz it appears to us that the artisan may well appreciate the capability of the plural systems discussed at columns 4 and 5 of this reference in conjunction with the examiner’s analysis of that as well as the plural parameters required there address the argued features, particularly in view of the fact of what the claim does and does not recite. The plural test systems generally taught in Slutz to the artisan clearly may call upon correspondingly identical data files to perform the same or perhaps even different tests because the nature of the systems may be different. The breath of the subject matter actually presented in claim 1 is more general than the specific nature of the arguments presented by appellant. Appellant’s remarks in the reply brief and supplemental reply brief believing that Slutz required a different configuration file to be used to perform different tests appear to indirectly argue that the references are incapable of conveying to the artisan the ability to perform in plural systems, based upon the same configuration files, the same test. Therefore, we sustain the rejection of independent claims 1 and 2 based upon Slutz alone.

On the other hand, we agree with the appellant’s views expressed in the various briefs with respect to the rejections of claims 5 through 13 in the first stated rejection relying upon Slutz in view Fujimori. We agree with appellant’s various arguments that there is no motivation or convincing line of reasoning of the examiner

to combine the teachings of Slutz with those of Fujimori, and that Fujimori is not analogous art in accordance with existing case law precedent. Plainly, Fujimori, being an electronic musical instrument environment, is not in the same field of invention as the test systems of Slutz and we are convinced, based upon consideration of this reference and appellant's arguments, that Fujimori would not have been reasonably pertinent to the artisan to the subject matter of Slutz and the present invention.

Notwithstanding the examiner's repeated efforts in the answer and the supplemental answer to convince us of the propriety of combining Fujimori with Slutz, we simply can not agree with the examiner's rationales and must necessarily conclude that the examiner has exercised prohibited hindsight in attempting to combine the teachings of Fujimori with Slutz. Because the examiner has not convinced us of the propriety to sustain the rejection of claims 5 through 13 in the first stated rejection relying upon Slutz in view of Fujimori, we must necessarily reverse the second and third stated rejections which also rely upon these two references even though additional teachings in Talley and Walls do not make up for the weakness of the applicability of Fujimori which is relied upon for all of the rejections. Therefore, to the extent the examiner rejects claims 3 through 14, 17 through 21 and 23 through 32, in the first three stated rejections, they are all reversed.

Next, we turn to the rejection of claims 1 through 14, 17 through 19, 23, 24, and 27 through 32 relying upon Gartner in view of Fitting. For the reasons set forth by the examiner in the answer and supplemental answer, we sustain this rejection as well as the fifth stated rejection of claims 20, 21, 25 and 26, further relying upon Walls. Page 20 of the principal brief on appeal does not provide any substantive argument as to the fifth stated rejection, relying apparently upon the arguments presented as to the fourth stated rejection relying upon Gartner and Fitting.

We agree with the examiner's reasoning of combinability at pages 8 through 11 of the initial answer regarding the particular teachings and showings and reasoning of combinability as it applies to Gartner in view of Fitting with respect to the fourth stated rejection. As argued by appellant beginning at page 16 of the principal brief on appeal, we recognize that Gartner does not apparently teach the applicability of his invention to first and second test systems. To the extent the examiner appears to rely upon the ability of the reference to relate to plural applications alone, perhaps within the same system, as comprising plural test systems the examiner's view is misplaced. Gartner appears to focus upon one test system but the ability to perform a test with respect to a plurality of separate users.

On the other hand, the reference to Fitting plainly teaches the ability in figure 1 to apply his teachings to a plurality of test systems represented by elements 106 through 109. Each of these test systems may use the same test data to test the same or

even different modeled products 100 that may be conveyed along conveyance 110 in figure 1. The host computer 122 provides accessibility to shared files within the database 130 through the shared file directory 127 to the extent recited in the claims on appeal.

To embellish upon the examiner's reasoning of combinability, it appears to us from our study of Gartner and Fitting that the artisan would well appreciate that the teachings of Fitting obviously would have enhanced the operability of Gartner's system to make it usable within a plurality of test system environments. Additionally, the closing paragraph at column 7, lines 36 through 60 of Fitting teaches the distinct advantages of the approach followed by Fitting such that when information is placed in the name of a file and communicated by a test system, the recipient host computer can readily read the information based upon the name alone without having to perform a lot of other accessing functions. Furthermore, the showing of the accessibility of file information by file name in Figure 2 of Gartner and its ability to access an external file reference based upon the two parameters of the identification of the server as well as the name of a file obviously would have been complemented and enhanced by the additional teachings just mentioned in Fitting with the ability to seek the corresponding information necessarily based upon a product identifier as combined with or otherwise concatenated with particularly requested data types. The

complementary nature of the teachings of both Gartner and Fitting are compelling of the obviousness of combining them. Lastly, the bulk of appellant's arguments in the briefs relating to the fourth and fifth stated rejections relying upon Gartner and Fitting, and additionally Walls, treat only the teachings of Gartner alone without a corresponding consideration of the teachings of Fitting.

In summary, we have sustained the rejection of claims 1 and 2 but not the rejection of claims 5 through 13 in the first stated rejection relying upon Slutz in view of Fujimori. We have reversed the second stated rejection of claims 3, 4, 14, 17 through 19, 23, 24, and 27 through 32, relying on Slutz in view Fujimori, further in view of Talley. Likewise, we have reverse the third stated rejection of claims 20, 21, 25 and 26 relying upon Slutz in view of Fujimori and Talley, further in view of Walls. On the other hand, we have sustained the rejection of claims 1 through 14, 17 through 19, 23, 24, and 27 through 32, relying upon Gartner in view of Fitting. Likewise, we have sustained the separate rejection of claims 20, 21, 25 and 26 in the fifth stated rejection relying upon Gartner in view of Fitting, further in view of Walls. Since we have sustained at least one rejection for each claim on appeal, the decision of the examiner rejecting all claims on appeal under 35 U.S.C 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

**AFFIRMED**

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